

REMARKS/ARGUMENTS

Initially, Applicants would like to express appreciation to the Examiner for the detailed Official Action provided, for acknowledgement of Applicants' Information Disclosure Statements by return of the FORMS PTO-1449, and for acknowledgment that the drawings are acceptable.

Applicants also acknowledge with appreciation the indication that claims 12-16 are allowable and that claims 6-11 contain allowable subject matter on the Office Action Summary, and in Pages 6-8 of the Official Action.

Upon entry of the above amendments, claim 1-16 will have been amended, claim 17 will have been canceled without prejudice or disclaimer to the subject matter contained therein, and new independent claim 18 will have been added. In this regard, claims 1-16 have been amended (where appropriate) for stylistic purposes, to conform to amendments made to the preceding claims from which certain claims depend, and to remove the terms "means" and "step" from the claims. In this regard, Applicants expressly submit that the previous recitations of the terms "means" and "step" in the claims were not intended to invoke the restrictions of 112, 6<sup>th</sup> paragraph. Thus, no estoppel should be deemed to apply.

Claims 1-16 and 18 are currently pending. Applicants respectfully request reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

In regard to claims 6-16 (which the Examiner has indicated as either being allowable or containing allowable subject matter), Applicants submit that claim 6 is in

condition for allowance since this claim has been rewritten into independent form to include substantially all of the limitations of the base claim and intervening claim;

Applicants submit that claims 7 and 8 are in condition for allowance since claim 7 has been rewritten into independent form to include substantially all of the limitations of the base claim and intervening claim, and claim 8 depends from claim 7;

Applicants submit that claims 9-11 are in condition for allowance since claim 9 has been rewritten into independent form to include substantially all of the limitations of the base claim, and claims 10-11 depend from claim 9; and

Applicants submit that claims 12-16, which the Examiner indicated as being allowable in their original form, have been amended solely for stylistic purposes.

*As discussed supra*, the above-mentioned claims have been amended, where appropriate, for stylistic purposes and to conform to amendments made to preceding claims from which certain claims depend. Accordingly, because the claims are not identical to the original claims, the Examiner is encouraged to review all amendments.

Thus, because the indicated allowable subject matter is recited in respective independent claims, Applicants submit that claims 6-16 are in condition for allowance.

In the Official Action, the Examiner rejected claims 1-3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over HIRUTA (U.S. Patent No. 5,952,841) in view of SAKAI (U.S. Patent No. 5,650,732);

the Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over HIRUTA in view of SAKAI, and further in view of IKEDA (U.S. Patent No. 5,791,484); and

the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over HIRUTA in view of SAKAI and IKEDA, and further in view of ZAISER (U.S. Patent No. 6,624,646).

Without acquiescing to the propriety of the Examiner's rejection of claim 17, Applicants note that claim 17 will have been canceled upon entry of the present Response. Accordingly, the above-noted rejection of claim 17 is believed to be moot and should be withdrawn.

In regard to the rejections of claims 1-5, without acquiescing to the propriety of the Examiner's above-noted rejections, Applicants have amended claim 1 solely in order to expedite prosecution of the present application.

In this regard, Applicants submit that HIRUTA and SAKAI, alone or in any properly reasoned combination, lack any disclosure of the combination of elements as recited in amended claim 1.

In particular, claim 1 sets forth an image sensor test system including, inter alia, a first inverter configured to invert an image sensor supplied from the pre-test sensor stacker; a contact arm configured to pick up and move the inverted image sensor inverted by the first inverter, the contact arm being configured to bring input/output terminals of the inverted image sensor into electrical contact with a contact of the test head; and an attachment portion configured to attach the light source to the image sensor test system so as to place the light source beneath the image sensor.

Applicants submit that HIRUTA and SAKAI, alone or in any properly reasoned combination, lacks any disclosure of at least the above-noted combination of elements as recited in amended claim 1.

In setting forth the rejection, the Examiner asserts that HIRUTA discloses the general structure of the presently claimed test system. However, the Examiner acknowledges that HIRUTA does not disclose a stacker for storing the image sensors (*see* paragraph 2 on page 3 of the Official Action).

Nevertheless, the Examiner asserts that it would have been obvious to supply the acknowledged deficiencies of HIRUTA with the purported stacker of SAKAI.

However, contrary to the Examiner's assertions, Applicants submit that HIRUTA does not disclose the general structure of the presently claimed test system. More specifically, Applicants submit that the Examiner has not explained how or where, in the applied prior art, the presently claimed light source is disclosed (*see, page 2, paragraph 2 of the Official Action, where the Examiner discusses HIRUTA and makes no mention of the applied prior art disclosing the presently claimed light source*).

In this regard, Applicants submit that HIRUTA does not disclose at least the presently claimed attachment portion configured to attach the light source to the image sensor test system so as to place the light source beneath the image sensor.

Thus, even assuming, arguendo, that the teachings of HIRUTA and SAKAI have been properly combined; the proposed combination still would not have resulted in the features of the embodiments of the present disclosure, as recited in amended claim 1.

Additionally, Applicants submit that IKEDA and ZAISER do not disclose anything which can reasonably be considered to overcome the above-noted deficiencies of HIRUTA and SAKAI.

Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103 and allow all pending claims in the present application.

Applicants also submit that newly added claim 18 recites additional features of the presently claimed invention and is supported by at least Figure 3 of the present Application.

In view of the amendments and arguments herein, Applicants submit that independent claims 1 and 18 are in condition for allowance. With regard to dependent claims 2-5, Applicants assert that these claims are allowable on their own merit, as well as because they depend from independent claim 1 which Applicants have shown to be allowable.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the reference cited by the Examiner, either alone or in combination, and an indication to such effect is respectfully requested, in due course.

COMMENTS ON REASONS FOR ALLOWANCE

In response to the Statement of Reasons for Allowance contained in the Official Action (*see* paragraphs 5 and 6 of the Official Action dated February 19, 2008), Applicants wish to clarify the record with respect to the basis for the patentability of claims 6-16 in the present application. In this regard, while Applicants do not disagree with the Examiner's indication that certain identified features are not disclosed by the references, Applicants submit that each of the claims in the present application recite a particular combination of features, and that the basis for patentability of each of these claims is based on the totality of the particular features recited therein.

SUMMARY

Applicants submit that the present application is in condition for allowance, and respectfully request an indication to that effect. Applicants have argued the allowability of the claims and pointed out deficiencies of the applied references. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and is now believed to be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Hiroyuki KIKUCHI et al.



Bruce H. Bernstein  
Reg. No. 29,027

William E. Lyddane  
Reg. No. 41,568

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GREENBLUM & BERNSTEIN, P.L.C.  
1941 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191